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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/718,204 | 11/20/2003 | Jordon D. Honeck | P0020462.00 | 9800 |
| 27581 | 7590 | 01/30/2008 | EXAMINER | |
| MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924 | | | MANUEL, GEORGE C | |
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| | | | 3762 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/718,204 | HONECK ET AL. | |
| | Examiner | Art Unit | |
| | George Manuel | 3762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 November 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8, 11-16, 30-48 and 51 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8, 11-16, 30-48, 51 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 11-13, 15-16, 30-31, 33-41, 43, and 45-47 are rejected under 35 U.S.C. 102(b) as anticipated by Boser et al (U.S. 5676694). Referring to claims 1 and 30, Boser et al. teach an elongate lead body, a conductive coil, a conductive wire, and a conductive component with a first groove that holds the coil. The groove is attached to a crimp sleeve that is slid over and crimped to a conductor (see figures 1, 2, 4, 6-7, and 13 and column 1, lines 35-64). Because the definition of a groove is a long furrow or channel, the Examiner considers the conductive component to be part 315 (see figure 4), and the second groove 314 is the channel that runs perpendicular to the first groove that contains the uninsulated part of the wire. In the alternative, the Examiner considers the conductive component to be part 312, and the second groove is again the channel that contains the uninsulated part of the wire. In a second alternative, the Examiner considers the second groove to be the “curved portion” of the underside of the conductive component 315 holding the coil that is in contact with the crimping sleeve, which is crimped on the uninsulated portion of the wire, making an electrical connection between the coil and the wire (see figures 5-10). It is inherent to strip a wire, place the

uninsulated portion of the wire into a crimping sleeve and crimp the crimping sleeve in order to provide an electrical connection between two components.

Regarding claims 2 and 31, Boser et al. teach that the sleeve protrudes from the groove (see figure 9). With reference to claim 3, Boser et al. disclose that the conductor extends within a lumen of the lead body, that the coil extends around an outer surface of the lead, that the first side of the crimp sleeve is within a lumen of the lead and the protruding surface extends through the lead (see figure 13). With reference to claims 4-5, Boser et al. teach the cable has a proximal and distal portion with an insulative outer layer (see figure 4 and column 4, lines 54-59). Regarding claims 6 and 7, Boser et al. do not teach a first sidewall and second sidewall explicitly, but instead teach an outer circumference of the sleeve, having a first sidewall and a second sidewall that each extend to the opposite side (see figure 9).

With regards to claims 9 and 10, Boser et al. teach that the portion of the coil includes a single filar that can be welded or compressed within the groove (see figures 6-7 and column 4, lines 60-64). With reference to claims 11, 12, and 36-38, Boser et al. teach that the groove can contain a plurality of filars that are welded or compressed within the grooves as described above (see figures 9 and 10).

Referring to claim 13, Boser et al. teach that the coil forms a defibrillation electrode (see figure 4 and column 3, lines 55-56). Regarding claims 16 and 34, the component in which the groove is formed is made of tantalum (see column 4, lines 35-37). With reference to claims 15, 33, 35, and 43, the grain orientation of the second groove is perpendicular to the first groove (see figures 4, 6-7, and 9-10).

With reference to claims 39-41 and 45-47, the conductive component can be formed from platinum, stainless steel, or titanium (see column 4, lines 35-37). Claims 42 and 48 are considered to be product by process claims and therefore, the groove, the product, is being considered and the EDM process is not being considered. Further, Boser et al. teach the groove as described above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7, 11-13, 15-16, 30-31, 33-41, 43, and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boser et al.

Boser et al is considered to anticipate the claimed features of a first side wall and a second side wall in addition to a first groove comprising the interface between 315 and 312 and a second groove 314 for holding a portion of the coil. In the alternative, one of ordinary skill in the art would have found it obvious to separate element 315 from element 312 to change the location along element 312 for the placement of element 315.

In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.")

Claims 8, 14, 32, 44 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boser et al. Boser et al. disclose the claimed invention, but do not disclose expressly welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the crimp sleeve with the two grooves as taught by Boser et al. with the welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively, because the Applicant has not disclosed that welding the wire within the groove, forming the conductive component of strip stock, and forming the second

groove with a plurality of grooves, respectively, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the Applicant's invention to perform equally well with crimping the conductor; forming the groove from tantalum, platinum, titanium, or stainless steel; a single groove for the second groove, respectively, as taught by Boser et al. because it secures the wire within the groove; the materials are biocompatible; and the single groove holds the wire, respectively, and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Boser et al. Therefore, it would have been an obvious matter of design choice to modify Boser et al. to obtain the invention as specified in the claims.

Further, Boser et al. disclose the claimed invention except for welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electrical lead as taught by Boser et al, with welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively since it was well known in the art that welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively, secures the wire within the groove; the material is biocompatible; and the plurality of grooves secures the wire in multiple places, respectively.

Response to Arguments

Applicant's arguments filed 10/31/07 have been fully considered but they are not persuasive. In response to applicant's argument that Boser fails to show a first groove holding a wire or cable when a second groove holds a portion of the coil is without merit. Boser does show in Fig. 6 a first groove where element 315 meets element 312 and a second groove 314 that holds a portion of a coil.

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sherman (US 3,789,374) disclose grooves for holding a coiled wire in position around an elongated body.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.

/George Manuel/
Primary Examiner
Art Unit: 3762